

DEC 05 2005

10/692,885

MS306692.01/MSFTP545USB

REMARKS

Claims 1-37 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

**I. Rejection of Claims 1, 2, 5-16, 18, 21 and 23-28 Under 35 U.S.C. §102(e)**

Claims 1, 2, 5-16, 18, 21 and 23-28 stand rejected under 35 U.S.C. §102(e) as being anticipated by Knutson *et al.* (US 5,870,746). Withdrawal of this rejection is requested for at least the following reasons. Knutson *et al.* does not disclose or suggest all aspects set forth in the subject claims.

A single prior art reference anticipates a patent claim only if it *expressly or inherently describes each and every limitation set forth in the patent claim.* *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 63 USPQ2d 1597 (Fed. Cir. 2002); *See Verdegaa Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The *identical invention must be shown in as complete detail as is contained in the ... claim.* *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Applicants' claimed invention relates to an information agent system, application and methodology wherein the information agent system, for instance, provides a platform for executing information agent applications. The information agent applications that are supplied can then be programmed, for example, by end-users and employed as end-user executive assistants or agents. To this end, independent claims 1 and 18 recite similar limitations, namely: *a plurality of folders comprising links to particular data files stored in the data storage component, the content of the folders controlled at least in part by end-user specified preferences, the folders include any type of link collection defined by a set of relationships.* Knutson *et al.* does not disclose or suggest these exemplary features of the invention as claimed.

Knutson *et al.* relates to expert systems and reporting systems, and more particularly to a system and method for generating reports from a computer database. The Examiner asserts that the cited document at col. 8, lines 1-6, col. 44, lines 13-14, col.

10/692,885

MS306692.01/MSFTP545USB

36, lines 30-32 and col. 7, lines 53-54 provides *a plurality of folders comprising links to particular data files stored in the data storage component*. Applicants' representative disagrees. Col. 8, lines 1-6 disclose a client subsystem that includes a log-in module, folder management subsystem, segment builder, measure builder and measure relationship builder, analyst definition subsystem, InfoFrame viewing subsystem and MDT Administrator interface. Col. 44, lines 13-14 provide that a message code should be linked in both the sending and receiving processes. Col. 36, lines 30-32 disclose a service that informs the InfoFrame viewing subsystem that a data file has been updated, and col. 7, lines 53-54 provides a database computer that includes one or more storage media. It would appear from the foregoing that the cited document, and the passages noted by the Examiner, provides a client subsystem having as one of its components a folder management subsystem (rather than a plurality of folders); that a message code (instead of a plurality of folders) is linked to both sending and receiving processes; that a service (rather than links incorporated within particular data files) informs an InfoFrame viewing subsystem that a data file has been updated; and that a data base includes a storage media. In view of the foregoing discrepancies, applicants' representative is perplexed as to how these disparate and unconnected items can be construed as relating to a plurality of folders comprising links to particular data files stored in a data storage component.

The Examiner further contends that *the content of the folders being controlled at least in part by end-user specified preferences* is disclosed at col. 43, lines 46-67, col. 8, lines 1-8, and col. 45, lines 30-31, of the cited document. Applicants' representative avers to the contrary. Col. 43, lines 46-67 provide that an mdt\_Message abstract base class defines an object that holds the content of an MDT interprocess message. In addition, as stated *supra*, col. 8, lines 1-6 disclose a folder management subsystem and col. 8, lines 6-8, further provide a log-in module that verifies that only one copy of the client subsystem is running on a computer. Moreover, col. 45, lines 30-31, state that control returns from the csm\_ReceiveProcess::Receive() function to the caller function. Applicants' representative is once again perplexed as to how the noted passages can be construed as being related to *the content of the folders being controlled at least in part by end-user specified preferences* as recited in the subject claim. It is submitted that the

10/692,885

MS306692.01/MSFTP545USB

indicated passages have no logical relationship with one another, and that the Examiner has undertaken a lexical search and identified incommensurate items within the cited document that neither disclose nor suggest the novel aspects of applicants' claimed invention.

Additionally, the Examiner contends that col. 62, lines 36-37 and col. 8, lines 11-13 provide *content of the folders being controlled at least in part by end-user specified preferences*. Col. 62, lines 36-37 disclose that Drill Down partitions may be specified by the user in the analyst definition, and col. 8, lines 11-13 provides that during logon a log-in module verifies a user's name and password and then retrieves any user preferences that may have earlier been defined. While applicants' representative acknowledges that user specified preferences may inherently be associated with the log-in module that verifies a user's name and password, the fact remains that the Examiner has failed to provide a logical basis upon which to base the assertion that Knutson *et al.* discloses the entirety of the subject claims.

In addition, the Examiner contends that col. 8, lines 1-6, col. 44, lines 13-14 and col. 12, lines 58-63 provide *the folders include any type of link collection defined by a set of relationships*. Applicants' representative disagrees. As has been stated above, col. 8, lines 1-6 provide a folder management subsystem, rather than a plurality of folders. Col. 44, lines 13-14, discloses that message code, in contrast to folders, should be linked to both sending and receiving processes. And col. 12, lines 58-63 states that one of the four types of fundamental metadata provided in Knutson *et al.* measure relationships that are simple expressions of business causality used to generate supporting information for an InfoFrame to alert a user to trends that run counter to the set of measure relationships. Applicants' representative is puzzled as to how this can be construed as pertaining to folders that are capable of including any type of link collection defined by a set of relationships.

In the Response to Arguments section of the Final Office Action the Examiner, in maintaining the current rejection, asserts that Knutson *et al.* inherently describes each and every limitation set forth in independent claims 1 and 18. Applicants' representative contends that the Examiner is subscribing to mere probabilities or possibilities in an attempt to found inherency to substantiate the instant 35 U.S.C. §102 rejection.

10/692,885

MS306692.01/MSFTP545USB

Inherency, however, may not be established by probabilities or possibilities. *The mere fact that a certain thing may result from a given set of circumstances is not sufficient.* If, however, the disclosure is sufficient to show *that the natural result flowing from the operation as taught would result in the performance of the questioned function*, it seems to be well settled that the disclosure should be regarded as sufficient. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (emphasis added).

The case law cited above is specific and certain. In order to show inherency it must be shown that there is at least some logical nexus that connects the disparate passages into a cogent or coherent whole so that the natural result flowing there from would result in the performance of the questioned function. It is submitted that the Examiner has failed to satisfy this threshold requirement for inherency. Rather all that is evident is that the Examiner has undertaken a lexical scan of *Knutson et al.* to find similar lexemes to that of the subject claim. However, the lexemes so located have no logical relation to one another. For example, the Examiner asserts that the cited document provides a folder management subsystem at col. 8, lines 1-6, and that col. 44, lines 13-14 provides the links disclosed in the subject claims. (See Final Office Action, page 14). However, as discussed *supra*, col. 44, lines 13-14 pertains to a message code that should be linked into both a sending and receiving process, whereas col. 8, lines 1-6 relate to a folder management subsystem. Applicants' representative therefore contends that the two illustrative passages cited above have no logical nexus between them sufficient to lead one of ordinary skill to inherently deduce that one is the natural consequence of the other.

The Examiner is reminded that in order to evaluate claim language every limitation in the claim must be considered, and further that "Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation." (See MPEP §2106(II)(C)). It is submitted that the Examiner rather than considering the claim as a whole, has dissected the claim into discrete elements and thereupon has conducted an evaluation of the elements in isolation of one another, so much so that the Examiner has failed to provide a substantive foundation to sustain the instant rejection.

10/692,885

MS306692.01/MSFTP545USB

Furthermore, the Examiner is reminded that the standard by which anticipation is to be measured is *strict identity* between the cited document and the invention as claimed, not mere equivalence or similarity. *See, Richardson* at 9 USPQ2d 1913, 1920. This means that in order to establish anticipation under 35 U.S.C. §102, the single document cited must not only expressly or inherently describe each and every limitation set forth in the patent claim, but also the identical invention must be shown in as complete detail as is contained in the claim. The fact that the Examiner has been unable, with sufficient clarity, to correlate and provide the necessary interconnection between disparate and unrelated items disclosed in *Knutson et al.* leads applicants' representative to believe that the strict identity required to substantiate this 35 U.S.C. §102 rejection is nonexistent.

Accordingly, in view of at least the foregoing, withdrawal of the rejection of independent claims 1 and 18 (and claims that depend there from) is respectfully requested.

**II. Rejection of Claims 3 and 4 Under 35 U.S.C. §103(a)**

Claims 3 and 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Knutson et al.* as applied to claim 1 above, and further in view of Bailey ("On-Event-Condition-Action Language for XML"). This rejection should be withdrawn for at least the following reasons. Claims 3 and 4 depend from independent claim 1; and Bailey does not cure the aforementioned deficiencies of *Knutson et al.* with respect to independent claim 1. Accordingly, withdrawal of the rejection of claims 3 and 4 is requested.

**III. Rejection of Claims 17 and 29 Under 35 U.S.C. §103(a)**

Claims 17 and 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Knutson et al.* as applied to claims 1 and 18 respectively, and further in view of *Ku et al.* (US 6,532,471). Withdrawal of this rejection is requested for at least the following reasons. Claims 17 and 29 depend from independent claims 1 and 18 respectively, and *Ku et al.* does not make up for the deficiencies of *Knutson et al.* with respect to independent claims 1 and 18. Accordingly, it is believed that claims 17 and 29 are in condition for allowance and that this rejection should be withdrawn.

10/692,885

MS306692.01/MSFTP545USB

**IV. Rejection of Claims 19, 20 and 22 Under 35 U.S.C. §103(a)**

Claims 19, 20 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Knutson as applied to claims 1 and 18 above respectively, and further in view of Thuraisingham (US 5,481,700). This rejection should be withdrawn for at least the following reasons. Claims 19, 20 and 22 depend from independent claim 18, and Thuraisingham does not cure the deficiencies with respect to the primary reference, Knutson *et al.*, with respect to such claim. Accordingly, this rejection should be withdrawn.

**V. Rejection of Claims 30-37 Under 35 U.S.C. §103(a)**

Claims 30-37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Knutson *et al.* (US 5,870,746), Watters (US 6,490,718), and Saxe (US 6,343,376). Withdrawal of this rejection is requested for at least the following reasons. Knutson *et al.*, Watters and Saxe, either alone or in combination, fail to teach or suggest all aspects set forth in the subject claims.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must be found in the prior art and not based on the Applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

Independent claim 30 recites *writing user preferences with respect to one or more named groups of data in accordance with a developer schema; executing user preferences in response to an event; and taking action based on a conditionally valid*

10/692,885

MS306692.01/MSFTP545USB

*preference*. Neither Knutson *et al.*, Watters nor Saxe, individually and/or in combination, teach or suggest all the novel aspects of applicants' claimed invention.

In the Response to Arguments section of the Final Office Action the Examiner, in maintaining the current rejection, asserts that Knutson *et al.* teaches *writing user preferences* at col. 15, lines 59-62 and col. 8, lines 11-13. Applicants' representative disagrees. While applicants' representative is cognizant that the lexemes identified and highlighted by the Examiner (*i.e.*, "user specifies", "writes", and "user preferences") can be located within the passages cited, the contextual relationship of the identified lexemes with one another and between the disparate unrelated citations nevertheless do not import the meaning that the Examiner seeks to propound as being the language as set forth in the subject claim. For example, col. 15, lines 59-62 relates to Analyst Definitions wherein a user specifies new Business Concepts and indicates where he/she wants them saved, such that a metadata load and update module writes them (*i.e.*, the new Business Concepts) back into a data warehouse for future use. Col. 8, lines 11-13 in contrast pertains to a client subsystem (an application program) that includes a log-in module that verifies that only one copy of the client subsystem is running on a computer, checks the localization of the computer, connects to the computer, and interacts with a user to log the user onto the client subsystem. During logon, the log-in module verifies the user's name and password and then retrieves any user preferences that may have been defined earlier. The Examiner nevertheless is of the opinion that "it is quite clear from these teachings that a user specifies user preferences, which are written to memory and later retrieved by the system when the user logs on." (See Final Office Action, page 18). It is perplexing to applicants' representatives' mind how these two contextually disjunct and logically unrelated passages can be coherently conjoined to teach or suggest *writing user preferences* as recited in the subject claim, when the noted passages themselves do not logically teach or suggest such aspects.

The Examiner further asserts that Knutson *et al.*, at col. 3, lines 48-53 and col. 3, lines 28-29, provides *in accordance with a developer schema*. Col. 3, lines 48-53 provides that an Analyst specifies an event in the data that must trigger an Alert; or specifies the type of analysis and the business measures and segments to be reported on in an InfoFrame, and optionally the schedule on which this InfoFrame is to be generated

10/692,885

MS306692.01/MSFTP545USB

or the event in the data that must trigger the InfoFrame. Col. 3, lines 26-29, discloses a system that includes four subsystems: a client subsystem, a data abstraction intelligence (DAI) subsystem, a data and schema manipulation subsystem and a scheduler subsystem. How these two disparate and unconnected citations can be combined to teach *in accordance with a developer schema* is quite beyond applicants' representative's comprehension. While it is acknowledged that the word "schema" does appear within the ambit of col. 3, lines 26-29, the schema so disclosed has no relation whatsoever with the Analyst specified event as provided in col. 3, lines 48-53. This leads applicants' representative to once again assert that the Examiner is straining the bounds of reasonableness and is gravely misconstruing the cited document in order for it to conform to a perception that is untenable based on the teachings of Knutson *et al.*

Additionally, the Examiner asserts that Knutson *et al.* provides *executing user preferences in response to an event* at col. 10, lines 25-26, col. 8, lines 11-13, col. 8, lines 53-54 and col. 44, lines 62-64. Col. 10, lines 25-26 provide that a Scheduled Analysis will be submitted to a server for execution at a later date or periodic execution. Col. 8, lines 11-13 disclose a log-in module that verifies a user's name and password and then retrieves any user preferences that may have been defined earlier. Col. 8, lines 53-54 state that folder objects are created and deleted by a folder management subsystem in response to user requests, and col. 44, lines 62-64 provide a set of events that occur as a message is transmitted from one process to another using MDT (Management Discovery Tool) typed stream handles and a message registry. While it is acknowledged that a Scheduled Analysis is submitted to a server for execution; that a log-in module retrieves user preferences; that folder objects are created and deleted by a folder management subsystem at the behest of a user; and that a set of events that occur as a message are transmitted between two processes, the foregoing does not teach or suggest executing user preferences in response to an event. In fact nowhere in Knutson *et al.* is the execution of user preferences in response to an event taught or suggested. Thus it is submitted there is no rational basis within the teachings of Knutson *et al.* to substantiate this rejection.

In relation to the secondary and tertiary documents cited by the Examiner, it is submitted that neither make up, either alone or in combination, for the aforementioned



10/692,885MS306692.01/MSFTP545USB

deficiencies of Knutson *et al.* The Examiner in the Response to Arguments section of the Final Office Action however states that "Since the Applicants have not challenged the teachings of Watters and Saxe the Examiner assumes that the limitation '... with respect to one or more named groups of data ...' is taught by Watters and the limitation, '... and taking action based on a conditionally valid preference ...' is taught by Saxe are indeed taught by Watters and Saxe." (See Final Office Action, page 20). Applicants' representative disagrees with such a statement. While it is recognized that neither Watters nor Saxe would need to replicate those aspects already taught or suggested by Knutson *et al.*, had Knutson *et al.* elucidated those aspects for which the Examiner places reliance, the fact remains that the primary reference does not teach or suggest the aspects upon which reliance is placed. Consequently, in view of Knutson *et al.*'s failure in this regard, Watters and/or Saxe must make up for those deficiencies neither taught nor suggested by the primary reference in addition to those aspect for which the Examiner places reliance upon the secondary and tertiary references. Accordingly, in view of at least the foregoing, withdrawal of this rejection with respect to independent claim 30, and associated dependent claims, is requested.

10/692,885

MS306692.01/MSFTP545USB

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP545USB].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP  
24<sup>TH</sup> Floor, National City Center  
1900 E. 9<sup>TH</sup> Street  
Cleveland, Ohio 44114  
Telephone (216) 696-8730  
Facsimile (216) 696-8731